



UNITED STATES PATENT AND TRADEMARK OFFICE

(Handwritten mark)

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,320	04/24/2001	Y. Tom Tang	PF-0627 USN	6653
7590 04/21/2004				
Incyte Genomics Inc Legal Department 3160 Porter Drive Palo Alto, CA 94304				
EXAMINER				
MERTZ, PREMA MARIA				
ART UNIT		PAPER NUMBER		
1646				

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,320

Applicant(s)

TANG ET AL.

Examiner

Prema M Mertz

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restriction

1. This application is a 371 of PCT/JP98/03603. For applications filed under 371, PCT rules for lack of unity apply.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains inventions or groups of inventions, which are not so linked as to form a single inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups I-4. Claims 1-2 and 15, drawn to a polypeptide of amino acid sequence set forth in SEQ ID NO:1-4.

Groups 5-8. Claims 3-6, 9-14, drawn to a polynucleotide encoding a polypeptide of amino acid sequence set forth in SEQ ID NO:1-4.

Groups 9-12. Claims 7-8, drawn to a method for detecting a polynucleotide encoding a polypeptide of amino acid sequence set forth in SEQ ID NO:1-4.

Groups 13-16. Claim 16, drawn to an antibody to a polypeptide of amino acid sequence set forth in SEQ ID NO:1-4.

Groups 17-20. Claim 17, drawn to an agonist to a polypeptide of amino acid sequence set forth in SEQ ID NO:1-4.

Groups 21-24. Claim 18, drawn to an antagonist to a polypeptide of amino acid sequence set forth in SEQ ID NO:1-4.

Groups 25-28. Claim 19, drawn to a method of treatment by administering a polypeptide comprising an amino acid sequence as set forth in SEQ ID NO:1-4.

Groups 29-32. Claim 20, drawn to a method of treatment by administering an antagonist to a polypeptide comprising an amino acid sequence as set forth in SEQ ID NO:1-4.

Should any one of the Groups from 1-32 be elected, Applicant is required to select one polypeptide (one amino acid sequence). Once one polypeptide sequence is selected, all other sequences will be withdrawn from consideration.

The inventions listed as Groups 1-32 do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2 they lack the same or corresponding special technical feature for the following reasons:

The PCT rules define a special technical feature as a feature, which defines a contribution over the prior art. The first claimed invention fails to recite such a feature, since a fragment of the polypeptide would potentially be a single amino acid. Brandt et al. disclose an epidermal growth factor-related protein: Cripto-1 (see abstract). Therefore any single amino acid disclosed in the prior art reference protein meets the limitations of instant Group 1. Since the first claimed invention lacks a special technical feature, the other claimed inventions cannot share a special technical feature with the first claimed invention.

The inventions of Groups 1-4 are patentably distinct from the products of Groups 5-8 because the protein product can be made by a materially different method, such as isolated from natural sources. The invention of Groups 1-4 are patentably distinct from the products of Groups 1-4 because the products of Groups 1-4 can be used in methods that are materially different from the detection of Groups 9-12, such as in the production of antibodies. The methods of Groups 9-

Art Unit: 1646

12, 25-32 are patentably distinct because each recites method steps, starting materials and goals not required by the other, and the search of all methods in one patent application would result in an undue search burden.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (571) 271-0871.

Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Information regarding the status of an application may be obtained from the Patent application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Prema Mertz
Prema Mertz Ph.D.
Primary Examiner
Art Unit 1646
April 8, 2004